

Shunji SATO

Practice Area

Trademarks / Designs / Unfair Competition / Intellectual Property
Litigation and Trials / Brands

Education

Santa Clara University School of Law (LL.M., 2007)
Keio University (LL.B., 1997)

Admission

Qualified as a Litigating Patent Attorney ("Huki-Benrishi") (2005)
Japan Patent Attorneys Association (JPAA) (2002)

Experience

TABLE FOR TWO International Specified non-profit Corporation, Board
of Directors (2018-Present)
International Trademark Association (INTA), (Board of Directors, 2016-
2018; Asia-Pacific Global Advisory Council, 2016-Present)
TMI Associates (Paralegal, 1997-2002; Associate, 2002-2011; Partner,
2012-Present)
Morgan, Lewis & Bockius LLP, San Francisco (2007-2008)

Languages

Japanese / English

Memberships

International Trademark Association (INTA), Board of Directors (2016-
2018), Asia-Pacific Global Advisory Council (2016~Present)
East Asia & Pacific Subcommittee of the Famous and Well-Known Marks
Committee Chair (2018-Present), Member (2016-2017), Co-Chair of the
2015 Regional Conference in Tokyo ("Trademarks in Japan")
Roundtable Committee (2013-2015)
East Asia & Pacific Subcommittee of the Non-Traditional Marks
Committee (NTM) (2012-2015)
Japan Intellectual Property Arbitration Center (JIPAC), Panelist
candidates for JP Domain Name Dispute Resolution (2015-Present)
Japan Trademark Association (JTA), Board member (2012- Present),
International Committee Chair (2012-Present), Vice-chair (2010-2011),
Member (2009-Present)
Asian Patent Attorneys Association (APAA), Trademark Committee
(2010-Present)
Japan Patent Attorneys Association (JPAA) (2002), Trademark
Committee Chair (2013), Vice-chair (2010-2012), Member (2009-
2014), International Activities Center (2015-Present), Central Research
Institute of Intellectual Property, External researchers (2017-Present)



Articles & Publications

2019/03/31	ARTICLE	"Use' of Marks in the Countries Where Protection Is Sought as a Requirement for the Protection of a Well-Known Mark – Focusing on Case Studies in the U.S. and the EU"
2018/04/16	ARTICLE	"The IP High Court overturned the JPO's Trial Board Decision relating to likelihood of confusion with the famous Red Bull mark"
2018/01/21	ARTICLE	"The Latest Trends in New Types of Marks: Sound Mark Consisting only of Musical Elements Registered for the First Time"
2016/12/07	ARTICLE	"Japan IP High Court Rules in Favor of Franck Miura over Franck Muller"
	ARTICLE	"BREXIT – the UK's Exit from the EU"
2016/05/27	BOOK	"Professional Practice Regarding Intellectual Property Due Diligence Leading to Successful M&A [3rd Edition]"
2015/12/25	ARTICLE	"Current Examination of Applications for Non-Traditional Marks"
2015/12/21	ARTICLE	"Recent Trends of Three-dimensional Trademarks in Japan" and "Recent IP High Court Decisions-IP High Court and District Court Cases in 2014 where Similarity between the Marks Was Discussed"
2015/09/29	ARTICLE	"Japan Business Review Updated – Trademark Law Update 2015"
2015/03/12	ARTICLE	"Recent Important Court/TTAB Decisions regarding Trademark Dilution Revision Act"
2014/10/23	ARTICLE	"Trademark Law Update 2014"
2014/10/31	ARTICLE	"Investigation into the Trademark Registration of Japanese Geographical Names in Major ASEAN Countries"
2014/07/11	ARTICLE	"Protection of Trade Name in Asian Countries (Vol.3) (Final Edition)"
2014/06/01	ARTICLE	"Some practical tips for non-Japanese trade mark applicants seeking to protect trade marks in Japan using the Madrid Protocol"
2014/05/14	ARTICLE	"Protection of Trade Name in Asian Nations (Part 1)"
2014/04/01	ARTICLE	"Recent IP High Court Decisions and JPO Appeal/Trial Board Decisions including Opposition Decisions"
2013/07/02	ARTICLE	"Protection of Colors and Designs under the Trademark Act"
2013/04/05	BOOK	"Professional Practice Regarding Intellectual Property Due Diligence Leading to Successful M&A [2nd Edition]"

Other Articles & Publications

2016/09	BOOK	"Comprehensive List of Intellectual Property Legal Precedents 2014 Vol.2," (Editor), SEIRIN SHOIN
2016/08	BOOK	"Comprehensive List of Intellectual Property Legal Precedents 2014 Vol.1," (Editor), SEIRIN SHOIN
2013/04	ARTICLE	"Recent IP High Court Decisions and Appeal/Trial Board Decisions including Opposition Decisions (2) IP High Court and District

	Court Cases in 2012 where the similarity between like marks and likelihood of confusion was discussed," (Co-Author), JTA BULLETIN, Issue No.18
2012/04	ARTICLE "Recent IP High Court Decisions and Appeal/Trial Board Decisions (2) Similarity," (Co-Author), JTA BULLETIN, Issue No.17
2011/02	ARTICLE "Non-traditional marks expanding in Japan," (Co-Author), Managing Intellectual Property
2011/01	ARTICLE "Recent IP High Court Decisions and Appeal Board Decisions (2) Similarity," (Co-Author), JTA BULLETIN, Issue No.16
2010/01	ARTICLE "Recent Decisions by the JPO Board of Appeal (2) Cases where the similarity of marks was discussed," (Co-Author), JTA BULLETIN, Issue No.15
2010	BOOK "A Professional Dictionary of Intellectual Property Terms (Chiteki-zaisan Purofessionaru Yogo Jiten)," (Co-Author), Nikkei Business Publications, Inc.,(in Japanese)
2008	ARTICLE "Well-Known Marks Doctrine in the United States - Territoriality and Protection for Well-Known Marks -" PATENT Vol. 61 No. 5 (in Japanese)
2006	ARTICLE "Practical Searching and Proper Use of Trademarks Considering Recent Precedents"; "Chizai Kanri" Intellectual Property Management, Vol. 56 No.5 (in Japanese)
2004/05	ARTICLE "PLC Cross-border Handbooks: Intellectual Property 2004/05 (Japan Chapter)," (Co-Author), Practical Law Company

Seminars & Lectures

2019/09/21	EXTERNAL	"2019 Promotion Project for Comprehensive Cooperation in the Protection of Intellectual Property (Second Researchers' Meeting on the Japan-China Joint Research) – How Well-Known Marks of Foreign Countries should be Protected [‘Use’ of Marks in the Countries Where Protection Is Sought as a Requirement for the Protection of a Well-Known Mark - Focusing on Case Studies in the U.S. and the EU]"
2019/02/26	EXTERNAL	2019 JPAA IP Practitioners Seminar "Likelihood of Confusion – How do the courts decide?"
2019/02/01	EXTERNAL	"About U.S. Trademark Practice"
2019/01/11	EXTERNAL	"World Trends in Trademarks and INTA's Anti-Counterfeiting Activities"
2018/12/11	EXTERNAL	"The Latest Trends in Business Concerning Trademarks and Designs"
2018/12/03	EXTERNAL	Regional Workshop on the International Trademark Landscape – Topic 6 "Lost in Translation: How to Deal With Translation and Transliteration Issues"
2018/10/22	EXTERNAL	"Innovation Leaders Summit /JETRO Session /Laws and Regulations on setting up business in Japan – 'Trademark and Design Protection Systems'"
2018/09/01	EXTERNAL	"[Japan Patent Attorneys Association] Training Lecture for

Professionals – Step Up a Level – Trademark Search / Prosecution / Madrid Protocol; Part 1: Drafting of Search Reports and Handling Procedures under the Madrid Protocol”

2018/07/26	EXTERNAL	“Lecture on the Intellectual Property System of the Philippines ‘Application for Trademark Registration and the Implementation of Rights in the Philippines’”
2018/06/30	EXTERNAL	“Japan – Recent Trademark Cases – Battles between two “Bull” formative trademarks -”
2018/04/18	EXTERNAL	“Different views of the IP High Court and the JPO – Lessons from two ‘RB’ decisions”
2018/03/23	EXTERNAL	CITMA Spring Conference 2018 – International organisations in conversation – “Border control in Japan”
2017/11/27	EXTERNAL	“Protection of Well-Known and Famous Trademarks (General Theory) and Protection Levels of Well-Known and Famous Trademarks in Foreign Countries (the U.S., Europe and China)”
2017/10/27	EXTERNAL	International IP Rights: Tips and tricks international trade mark applications
2017/09/30	EXTERNAL	“Training Lecture for Trademark Practitioners (Advanced Level) (Trademark Search / Office Actions / Madrid Protocol) Part 2: Drafting Arguments I (Reason for Refusal Stipulated in Article 4.1.11)”
2017/03/02	EXTERNAL	IPAC-JPAA Meeting Open Seminar “How Patent Attorneys Work” and “How Trademark Attorneys Work”
2017/02/28	EXTERNAL	2017 JPAA IP Practitioners Seminar “Hague System”
2017/02/10	EXTERNAL	Practical Training for Patent Attorneys 2016, “4. Theories and Professional Practices Regarding Trademarks: ‘Responses to an Office Action’”
2017/01/25	EXTERNAL	“Project Commissioned by the Japan Patent Office: ‘Seminar on Intellectual Property in the Philippines’ ”
2016/11/11	EXTERNAL	“Introduction to Chinese Court Decisions for Trademark Opposition Cases in Relation to Merchandising Rights”
2016/10/28	HOSTED / CO-HOSTED	TMI Associates’ Special Seminar: “Practical Points under the New Chinese Trademark Law Learned from Latest Legal Precedents”
2016/09/24	EXTERNAL	“Training Lecture for Trademark Professionals (Beginner Level) Part 2: Drafting Written Opinions I (Reason for Refusal Stipulated in Article 4.1.11)”
2016/06/16	EXTERNAL	INTA-MOST Conference for Protection of Well-Known Trademarks – Enterprise’s Needs and Solutions- “Protection of Famous and Well-Known Trademarks in Japan”
2016/03/05	EXTERNAL	ASEAN IPA – 2016 Annual Meeting and Conference “The Hague Agreement for Designs – What are its implications?”
2016/03/01	EXTERNAL	“Overlapping Rights: The Interplay among Design Rights, Copyright, Trademarks and Trade Dress (Part 1)”
2016/03/01	EXTERNAL	“Overlapping Rights: The Interplay among Design Rights, Copyright, Trademarks and Trade Dress (Part 2)”
2016/02/29	EXTERNAL	“The Hague System: What You Need to Know in Ten Slides or Fewer”
2016/01/27	EXTERNAL	IP Practice in Japan Meeting of AIPLA 2016 Mid-Winter Institute “Current Examinations for Applications for Non-Traditional Marks in Japan”

2016/01/12	EXTERNAL	"Challenges and Requests Regarding Trademark Registration and Enforcement System in Vietnam"
2015/12/11	EXTERNAL	"Seminar on U.S. Precedents (Report on Study Results) – B&B HARDWARE, INC. v. HARGIS INDUSTRIES, INC. (Supreme Court Decision) (Issue Preclusion Resulting from TTAB Judgment) -"
2015/11/25	EXTERNAL	"Japan IP Laws on Trademarks" at round table on "Improving of the protection of mechanisms of trademarks" by Ministry of Justice of the Republic of Kazakhstan
2015/09/26	EXTERNAL	"Training Lecture for Trademark Professionals (Beginner Level); Part 2; Drafting Written Opinions I (Reason for Refusal Stipulated in Article 4.1.11)" on September 26, 2015.
2015/07/29	EXTERNAL	"Trademarks – Judgment on Similarity"
2015/07/03	EXTERNAL	"Research on the Trademark Registration of Japanese Geographical Names in Major ASEAN Countries"
2015/03/26	EXTERNAL	"Trademarks in Japan; 'SESSION I – Nontraditional Trademarks'" and "Trademarks in Japan; 'SESSION III – Geographical Indications'"
2015/02/21	MONTHLY	"Practices and Exercises on Trademark Examination (Deciding Similarity between trademarks)"
2015/01/27	EXTERNAL	the Vietnam-Japan IP-Seminar "Fostering IP Eco-system through TM exploitation" -"Japanese companies' TM exploitation in Vietnam"
2015/01/09	EXTERNAL	"Latest Amendments to Foreign Trademark Laws and Updates on the Latest Court Precedents"
2014/12/15	HOSTED / CO-HOSTED	INTA Asia Roundtable: "U.S. Trademark Prosecution for Japanese Practitioners" on December 15, 2014.
2014/10/18	EXTERNAL	"Preparation of Opinion Brief (Office Action due to Violation of Article 4, Paragraph 1, Item 11 in Trademark Act)"
2014/10/17	EXTERNAL	"The Strategy of Trademark and Design Protection in Smart Environments"
2014/08/22	EXTERNAL	"2014 Training for New Patent Attorneys: Trademarks – Judgment on Similarity"
2014/08/21	EXTERNAL	"Guidance on the Amendment to the Patent Act, etc. (Trademark Act) (Compulsory Subject – Group Training)"
2014/07/19	EXTERNAL	"Protection of Geographical Indication in Japan" and "Update on Japan Trademark Law and Practice / Recent Court Decisions – LADY GAGA IP High Court Decision –"
2014/04/23	EXTERNAL	"2013 Year in Review and Trends for 2014 – Summarized Explanation on Precedents Related to Trademarks of 2013 –"
2014/04/09	EXTERNAL	Meeting of the AIPLA Practice in Japan Committee and JTA "The registrability of performer names in Japan"
2013/12/17	EXTERNAL	"Recent IP High Court Decisions in Japan"
2013/09/27	EXTERNAL	"Points to Consider on Protection of Rights in Countries That Adopt the Principle of Use -For Proper Understanding of Principal of Use-"
2013/09/19	EXTERNAL	"Points to Consider on Protection of Rights in Countries That Adopt the Principle of Use -For Proper Understanding of Principal of Use-"
2013/06/05	HOSTED / CO-HOSTED	TMI Associates' Special Seminar "Explanations on Points to

Consider on Vietnamese Intellectual Property Laws (IP Laws) and Information Technology Laws (IT Laws)"

2008/09/16

EXTERNAL

Patent Attorney Shunji Sato will be giving seminars on September 12, 2008 in Osaka and September 16, 2008 in Tokyo.

Other Seminars & Lectures

- 2013/03/13 "2012 Year in Review and Trends for 2013 – Summarized Explanation on Precedents Related to Trademarks of 2012" (The 5th General Training Seminar of the Patent Attorneys Club)
- 2012/02/22 "The Latest Trademark Caselaw You Should Know – Review of Judgments Passed in 2010 and 2011" (The 3rd General Training Seminar of the Patent Attorneys Club)
- 2012/09/26-27 MLB/TMI Joint Seminar "New Opportunities and Challenges for Product Designs and Online Businesses"
- 2011/10/20 ~21 "The JPO's current practice that does not allow for consent letters" (INTA and JPAA Meeting, and INTA and JTA Leadership Meeting)
- 2008/09/12 External "International Situations Regarding Trademarks (U.S.) The Protection System for Trademarks in The US. and Hot Topics"
- 2011/9/9 "e-Discovery in Trademark Litigation" (Participated as a moderator in a presentation given by the AIPLA at the 20th Annual Meeting of the Japan Trademark Association)
- 2010/5/24 "Industry Breakout – Spending Less on Marks in the Toys, Games and Entertainment Industries" (Participated as a panelist at the INTA 132nd Annual Meeting)